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EXAMINER

WYCHE, MYRON

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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,550	Applicant(s) NO ET AL.	
	Examiner MYRON WYCHE	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9/20/10 have been fully considered but they are not persuasive. Applicant primarily argues:

- (1). (a) Jiang et al. would not have suggested combining sounds, because Jiang et al. merely discloses combining mechanisms not sounds; and
(b) Jiang et al. teaches replacement of ringing tones currently heard today but would not have suggested any combination of personal or subscriber information sound with a replacement sound.
- (2). Wilk, as applied to claims 1, 10 and 19, does not remedy the shortfalls of Kim et al. and Jiang et al.
- (3). Zhu et al., as applied to claims 1 and 19, does not remedy the shortfalls of Kim et al. and Jiang et al.
- (4). Smith, as applied to claims 1 and 10, does not remedy the shortfalls of Kim et al. and Jiang et al.
- (5). Zhu et al., as applied to claim 10, does not remedy the shortfalls of Kim et al., Jiang et al. and Wilk.

Regarding argument **(1)(a)**, it is respectfully submitted that Applicant's representative seems to focus this argument on paragraph **[0018]** of Jiang et al. where multiple paragraphs and figures (e.g., **FIGs., 1, 2, 4; and [0018], [0025], [0064] and [0066]**) were cited as disclosing these limitations. Further, the applicant has cited **[0019]** in his response which states:

“[w]hen the custom ringback mechanisms are use to support a terminating service, the calling party will hear the

custom **ringback tone, music clip, or announcement**
chosen by the terminating party" (emphasis added).

That is, the ringback "mechanisms" disclosed by Jiang et al. are in fact sounds (i.e., "ringback tone, music clip, or announcement").

Furthermore, regarding argument **(1)(b)**, paragraph **[0018]** of Jiang et al., as cited in the outstanding Office Action, states: "**combining** custom ringback mechanisms" (emphasis added), where as discussed in **(1)(a)** above, the ringback mechanisms to be combined are clearly sounds such as: "ringback tone, music clip, or announcement". Thus, in view of the above discussion, it is respectfully submitted that arguments **(1)(a)** and **(1)(b)** are moot.

With regards to arguments **(2) - (5)**, Applicant's arguments are moot because the cited references were not directed to the "shortfalls" of Kim et al., Jiang et al. or Wilk for the recited independent claims (i.e., 1, 10 and 19). For example, Wilk was cited to address the shortfalls or deficiencies of the combination of Kim et al. and Jiang et al. for **dependent claims 2, 11, 12 and 20** and not for **independent claims 1, 10 and 19**.

In addition, in response to applicant's arguments **(2) - (5)** against the references individually, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, as a result of the above discussion, it is respectfully submitted that the outstanding rejection using the cited art is maintained. The rejection is repeated below taking into account the present amendment.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 7/12/10 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

As a result of the present amendment, the outstanding drawing objection is withdrawn.

Specification

The amendments to the specification included in the present amendment are approved by the Examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5, 6, 10, 14, 15, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. 2007/0123311 (Kim et al.) in view of US Patent Application Publication No. 2004/0120494 (Jiang et al.).

Regarding claim 1 Kim et al. discloses: “a home location register (**FIG. 1: 12, 22; [0022]: “a single HLR may provide services to both switches”**) providing a call-terminating exchanger (**FIG. 1, 20: “T_MSC”**) with first information about whether or not a registered ringback tone is to be replaced (**FIG. 2: 100, 101; [0030]: “determines whether the called party is subscribed to the substitute ringback tone service”**) and second information for routing to sound providing means (**FIG. 1, 30: “substitute ringback tone playserver”**) when a calling terminal is registered in the call-terminating exchanger” (**FIG. 1: 12, 22; [0030]: “routes the call to the play server 30”**); and “the sound providing means (**FIG. 1, 30**) call-connecting to the calling terminal, detecting a specific sound set corresponding to the called terminal, and providing the calling terminal with the detected specific sound when the request of the call connection is received” (**FIG. 1: 10, 20, 30; [0024]: “sound information to reproduce and provide the calling party through the terminating switch 20 and the originating switch 10” ;FIG. 2: 101-105; [0030] - [0031]**).

However, Kim et al. does not appear to clearly disclose the remaining limitations of the invention. To that end, in the same field of endeavor (i.e., telephone networks with custom/substitute ringback tone capabilities) Jiang et al. discloses: “the call-terminating exchanger (**FIG. 1, 106: “GMSC”**) requesting a call connection to the sound providing means (**FIG. 1, 116: IP/IVR; FIG. 2: 230**) based on the first and the second information (**FIG. 2, 225: “GMSC”**) when the calling terminal requests a call to a called terminal” (**FIG. 2: 205; FIG. 4: 4; [0064]: “MSC routes the call to the IP/IVR over ANSI/ETSI ISUP via IAM”**); and “wherein the specific sound is generated by combining

a subscriber information sound for specific information (**FIG. 1, 116: IP/IVR; [0025]: “contain the specific audio/video clip to be played”**), which identifies a called subscriber or represent a character of the called subscriber (**FIG. 4: 5, 6; [0066]: “identifying which personalized Ringback to play”**), with a common ringback tone replacement sound set by the called subscriber” ([0018]: **“combining the custom ringback mechanisms with an existing IN service can be achieved”**).

It is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kim et al. with Jiang et al. in order to allow the subscriber to personalize and select from a wide variety of ringback tones that are made available via a database instead of using standard ringback tones available today (see Jiang et al. at [0007]). Claims 10 and 19 recite similar language to that discussed above for claim 1 and thus are also disclosed by Kim et al. and Jiang et al.

Regarding claims 3 and 21, Kim et al. discloses: “the subscriber information sound is inputted as a voice via an ARS” (**FIG. 1: 56**).

Regarding claims 5, 14 and 22, Kim et al. discloses: “the specific information includes at least one of a phone number, name, nick name and character of the called subscriber” ([0014]: **“the system changes the substitute ringback to of the user by storing the phone number of the user”**).

With respect to claims 6 and 15, Kim et al. discloses an existing Intelligent Network (IN) service with a general ringback tone in the form of: “a common ringback tone” (**FIG. 2: 102**); and a personal/custom ringback sound in the form of: “a substitute ringback tone” (**FIG. 2: 105**). In addition, Jiang et al. discloses: “the combination

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includes one or more among: (subscriber information sound)+(a general ringback tone); (subscriber information sound)+(the replacement sound)+(the subscriber information sound); (the replacement sound)+(the subscriber information sound)+(the replacement sound); (the subscriber information sound)+(a replacement sound 1)+(a replacement sound 2)+ (the subscriber information sound); (a subscriber information sound 1)+(the replacement sound 1)+(a subscriber information sound 2)+(the replacement sound 2); and (the replacement sound 1)+(the subscriber information sound 1)+(a replacement sound 2)+(the subscriber information sound 2)” ([0018]: “**combining the custom ringback mechanisms with an existing IN service can be achieved**”).

Claims 2, 11, 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. in view of Jiang et al. and US Patent No. 6,768,789 (Wilk).

Claims 2, and 11 and 12 are dependent upon claims 1 and 10, respectively. As discussed above, claims 1 and 10 are disclosed by Kim et al. and Jiang et al. Thus, those portions of claims 2, and 11 and 12 that are recited in claims 1 and 10, respectively, are also disclosed by Kim et al. with Jiang et al.

In addition, as recited in claim 2, Kim et al. also discloses: “a web server or WAP server” (**FIG. 1: 50, 52, and 54**).

However, Kim et al. and Jiang et al. do not appear to clearly disclose the remaining limitations of claims 2, 11 and 12. To that end, with respect to claims 2, 11 and 12, in the same field of endeavor (i.e., telephone systems with IVR and ringback capabilities), Wilk discloses: “text information of the subscriber (personal) information

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sound is converted into a voice by a text-to-speech engine” (**FIG. 2: 130; col. 6, lines 45-52: “generate a ringback to the caller” and “caller’s identity, which would be generated using known text-to-speech engines”**).

It is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kim et al. and Jiang et al. with Wilk in order to provide the subscriber with the additional option of generating a custom ringback tone/message in text form.

Further, regarding claim 12, Kim et al. discloses: “the personal information sound is inputted as a voice via an ARS” (**FIG. 1: 56**).

Furthermore, claim 20 recites similar limitations to claim 2 and thus, Kim et al., Jiang et al. and Wilk also disclose the limitations of this claim.

Claims 4, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. in view of Jiang et al. and US Patent Application Publication No. 2004/0203613 (Zhu et al.).

Claims 4 and claims 23 and 24 are ultimately dependent upon claims 1 and 19, respectively. As discussed above, claims 1, 10 and 19 are disclosed by Kim et al. and Jiang et al. Thus, those portions of claims 1, 10 and 19 that are recited in claims 4, 13, and 23 and 24 are also disclosed by Kim et al. and Jiang et al.

In addition, regarding claim 24, the combination of Kim et al. and Jiang et al. disclose custom ringback tones may include music as well as voice. Thus, it is respectfully submitted that it would have been obvious to provide a custom ringback

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tone that combines music and voice so that, as recited in claim 24: "the subscriber (personal) information sound is outputted as a voice to a melody."

However, Kim et al. and Jiang et al. do not appear to clearly disclose the remaining limitations of the claims. To that end, in the same field of endeavor (i.e., telephone systems with call alerting capabilities), Zhu et al. discloses: "a voice modulation device" that modulates or modifies the sound of "personal information" **([0006]: "mobile terminal can apply various modifications to a voice message and output the voice message with a different sound quality")**. It is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Kim et al. and Jiang et al. to further include the "voice modulation device" disclosed by Zhu et al. in order to "reflect the characteristics of the sender" (i.e., see Zhu et al. at **[0005]**) or characteristics of others (e.g., celebrity voices).

Claims 7-9 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. in view of Jiang et al. and US Patent Application Publication No. 2002/0193125 (Smith).

Claims 7-9 and 16-18 are dependent upon claims 1 and 10, respectively. As discussed above, claims 1 and 10 are disclosed by Kim et al. and Jiang et al. Thus, those portions of claims 7-9 and 16-18 that are recited in claims 1 and 10, respectively, are also disclosed by Kim et al. with Jiang et al.

However, Kim et al. and Jiang et al. alone do not clearly disclose the remaining limitations of the claims. To that end, in the same field of endeavor (i.e., telephone systems that indicate call related by the use of tones), Smith discloses: subscriber information sound and/or replacement sound that are “different by time zone” or “set by time zone” **([0004]: “user is made aware of an additional charge being incurred base on the user’s time zone, by the use of sound or vibration”)**.

It is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kim et al. and Jiang et al. with Smith in order to provide the subscriber with an call alert from the ringback tone that gives an indication of changing time zones.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. in view of Jiang et al., Wilk and Zhu et al.

Claims 13 is dependent upon claim 12. As discussed above, claim 12 is disclosed by Kim et al., Jiang et al. and Wilk. Thus, those portions of claim 13 that are recited in claim 12 are also disclosed by Kim et al., Jiang et al. and Wilk.

However, Kim et al., Jiang et al. and Wilk do not appear to clearly disclose the remaining limitations of the claim. To that end, in the same field of endeavor (i.e., telephone systems with call alerting capabilities), Zhu et al. discloses: “a voice modulation device” that modulates or modifies the sound of “personal information” **([0006]: “mobile terminal can apply various modifications to a voice message and output the voice message with a different sound quality”)**. It is respectfully

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submitted that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Kim et al., Jiang et al. and Wilk to further include the “voice modulation device” disclosed by Zhu et al. in order to “reflect the characteristics of the sender” (i.e., see Zhu et al. at [0005]) or characteristics of others (e.g., celebrity voices).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Application Publication No. 20050096006 discloses a subscriber selectable alternative to audible ringback signals. US Patent No. 7,509,149 discloses a method and apparatus for changing a sound source of a supplementary service using a ring back tone on calling.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MYRON WYCHE whose telephone number is 571-272-3390. The examiner can normally be reached on Monday-Friday, 8 a.m. to 5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Myron Wyche/
Patent Examiner
Art Unit 2617

December 2, 2010 /Dwayne D. Bost/
Supervisory Patent Examiner,
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